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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,048	06/29/2006	Joao Jorge Bergner	3731	6190
7590 Striker, Striker & Stenby 103 East Neck Road Huntington, NY 11743			EXAMINER OMAR, AHMED H	
			ART UNIT 4148	PAPER NUMBER
			MAIL DATE 08/19/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/585,048

Applicant(s)

BERGNER, JOAO JORGE

Examiner

AHMED OMAR

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/29/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The instant application having Application No. 10/585048 filed on 06/29/2006 is presented for examination by the examiner.

Oath/Declaration

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

Priority

3. As required by **M.P.E.P. 201.14(e)**, acknowledgement is made of applicant's claim for priority based on applications filed on 10/21/2005 (PCT/EP/05/55456) and 12/15/2004 (DE102004060294.8)

Drawings

4. The applicant's drawings submitted are acceptable for examination purposes.

Information Disclosure Statement

5. As required by M.P.E.P. 609, the applicant's submissions of the Information Disclosure Statement dated 06/29/2006 is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending.

Objections to the Specification

6. If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119 (a)-(d), a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under

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37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Objections to the claims

7. **Claim 10** is being objected to as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Regarding claim 10, the phrase "capable of being" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1, 2, 6, 7 and 11** are rejected under 35 U.S.C. 102(b) as being anticipated by Mather et al. (GB 2397704 A).

As per **claim 1**, Mather et al. discloses a device with a power tool case (See Fig.1) that includes at least one receiving area for a power tool (See Fig.1, Item#1, case and Description, Par.4 discloses the case is for the storage of the power tool) and a charger (See Fig.1 Item#3, ports, and Description Par.7 discloses the charging ports are power by battery chargers of known types), wherein the charger and the power tool case are designed to remain connected during a charging procedure (Description, Par.4 discloses the case is supplied with the charger as an integrated part of the case and not as a stand alone charger). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claims 7 and 11**, the charger and the power tool case for the device in claim 1 are disclosed as recited above in the claim 1 rejection.

As per **claim 2**, Mather et al. discloses the device as recited in Claim 1 recited above,

wherein the power tool case includes installation space (See Fig.1, Item#2, charging panel) for the charger (See Fig.1 Item# 3), and the charger is designed to remain in the installation space of the power tool case during the charging procedure (Description, Par.4 discloses the case is supplied with the charger as an integrated part of the case and not as a stand alone charger). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per claim 6, the device as recited in Claim 1 above, wherein the charger includes a wind-up device for a power cord (See Fig.1, Item#5, retractable flex, and description, par.4 discloses the flex cord for the charger is housed inside the structure of the case with a pullout and lock and press button retraction system).

10. Claims 1, 3, 4, 5 and 7 are rejected under 35 U.S.C. 102 (b) as being anticipated by Burrus, IV et al. (US 6571949).

As per claim 1 Burrus, IV et al. discloses a device with a power tool case (See Fig.2, Item#100, case) that includes at least one receiving area (See Fig.2, Item#101, power tool receiving area) for a power tool (See Fig.1, Item#104) and a charger (See Fig.1, Items# 101,102,103; 3 charging compartments, and Par.19, discloses the compartments include charging circuitry), wherein the charger and the power tool case are designed to remain connected during a charging procedure (See. Par.19 and 20; discloses the electrical connector in the power tool case delivers electrical power to the charging circuitry within the compartment 101 in Fig.2). *The*

Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.

As per **claim 3**, Burrus, IV et al. discloses the device as recited in claim 1 above, wherein the connection (See Fig.2, Item#105, electrical connector) between the charger (See Fig.2, Item# 101,102,103, charging compartments) and the power tool case (See Fig.2, Item# 100) is designed to be detachable (Par.23, discloses the compartments (chargers) can be fixed or removable, Par.19 discloses the compartments include charging circuitry). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 4**, Burrus, IV et al. discloses the device as recited in Claim 3, wherein the charger (See Fig.1, Item# 101,102,103) is connected with the power tool case (See Fig.1, Item# 100) via at least one detachable fastening means (See Fig.1, Item#105, connector, and Par.23, discloses that the compartments (chargers) can be fixed or removable).

As Per **claim 5**, Burrus, IV et al. discloses the device as recited in Claim 4 above, wherein the fastening means (See Fig.2, Item#105) is designed to be actuated without the use of tools (See. Fig.2, Electrical connectors 105 snap on and off to electrical connectors within compartments 101, 102 and 103). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 7**, Burrus, IV et al. discloses a charger for a device as recited in claim 1 above (See Fig.1, Items# 101,102,103, and Par.19 discloses compartments include charging circuitry).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claim 8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrus, IV et al. (US 6571949) in view of Hyodo et al. (US 6066938)

As per **claim 8**, Burrus, IV ET al. discloses the charger as recited in Claim 7 but does not disclose that it is designed as a stand for the power tool.

Hyodo et al. discloses a charger (See Fig.10, Item#20) designed as a stand for the power tool (See Fig.10, Item#1).

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention to achieve a dual function stand and charger which would facilitate the placement and removal of the tool on and off the charger by providing as easier way

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to grip the handle. *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 9**, Burrus, IV ET al. and Hyodo et al. disclose the charger in claim 8 as recited above, in which the power tool (See Fig.10, Item#1) is capable of being positioned at least substantially in the machining direction (See Fig.10, power tool placed on the charger in the machining position)

As per **claim 10**, Burrus, IV et al. and Hyodo et al. disclose the charger as recited in Claim 8 above characterized by a coupling unit (See Fig.5, Item#43, positive and negative terminals on the power tool handle) that is designed to correspond with a coupling unit of a power tool unit (See Fig.2, Item#10, positive and negative electrodes on the charger) while the stand function is being performed and to at least transmit charging energy (See Col.1, lines 61-67, and Col.2, lines 1-11, disclose the electrical connection established between the first set of terminals on the power tool handle and the second set of terminals on the charger when the power tool is placed on the charger). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

Conclusion

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13. The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See **MPEP 707.05(c)**.

The following reference teaches a battery driven screw driver that includes a charger which is also used as a stand, wherein the power tool is placed on the charger in the machining direction while being charged: US 2006/01925227.

The following reference teaches a power tool and that includes a charger, the charged also serves as a stand during charging: US 2006/0260964.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED OMAR whose telephone number is (571)270-7165. The examiner can normally be reached on Monday-Thursday 06:30-15:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Pham can be reached on 571-272-3689. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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4148

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